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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,501	04/17/2001	Lawrence M. Kaplan	N0089US	8539

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EXAMINER

LOUIS JACQUES, JACQUES H

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/836,501

licant(s)

KAPLAN, LAWRENCE, M.

Examin r

Jacques H Louis-Jacques

Art Unit

3661

-- The MAILING DATE of this communication appears n th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-17, 20-33, 35-41 and 43-46 is/are rejected.
- 7) ☒ Claim(s) 18, 19, 34 and 42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 39 recites the limitation "the administrative zones" in line 2. There is insufficient antecedent basis for this limitation in the claim.

It is believed that claim 39 should depend on claim 38.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 3661

4. Claims 8-9, 20-23, 24-33, 35, 40-41, 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Hashimoto [6,338,020].

Hashimoto discloses a mobile device for providing navigation-relates service to a user, wherein the device comprises a memory (18) for storing geographic data to provide navigation services and for storing wireless coverage data to identify a wireless coverage area (figures 1 and 2) and a processor (control unit, 16) operatively coupled to the memory (figure 1) to wirelessly download geographic data and store the geographic data in the memory (column 2). According to Hashimoto, when the user uses the geographic data to travel to a destination, before the user is expected to travel beyond the wireless coverage area (column 1, lines 54-56), the processor wirelessly downloads sufficient geographic data for the uncovered wireless coverage areas through which the user is expected to travel. See abstract, columns 4-5. As described in columns 1 and 3, more particularly, the processor automatically downloads sufficient data for the uncovered areas through which the user is expected to travel (i.e., based on a guide route from a current position to a destination). Hashimoto further discloses that the processor provides real-time features relying on the availability if data wirelessly using data that have been downloaded prior to leaving the wireless coverage area or entering the uncovered wireless data. Furthermore, as described in column 1, the processor provides the real-time features for a period of tome until they become obsolete, i.e., when the data or information is no longer necessary. See also column 4. Hashimoto also discloses downloading data representing types of geographic features (e.g., gas stations,

restaurants, etc.) See column 1. In columns 3 and 4, Hashimoto discloses downloading road segment data.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-10, 14-17, 20-23, 24-33, 35-41, and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al [6,400,690] in view of Hashimoto [6,338,020]

Liu et al discloses a dual map system for navigation and wireless communication, wherein a user using a computing device (110) establishes a wireless communication link through a wireless communications device (115) with a remotely located navigation services provider (101). According to Liu et al, as set forth in the abstract and column 2, for example, the user obtains wireless coverage data from the remotely located navigation service provider for establishing a wireless communications link and obtains wireless navigation services coverage data for the remotely located navigation service provider. According to Liu et al, the wireless navigation services coverage data indicated areas in which navigation-related are available or unavailable wireless. See abstract. The system includes a coverage manager for indicating areas in which navigation-related data from the navigation services provider are available or unavailable wirelessly, i.e., the system indicates the user whether he/she is an area covered wirelessly. See columns 3 and 4. Liu

et al further discloses an output device (111), such as a display (column 2) for displaying, on a screen, areas in which navigation related data from the services providers are available or unavailable wirelessly. Furthermore, Liu et al discloses, as described in the abstract and column 2, in particular, providing a warning to the user that he is or he is out of an area covered wirelessly by the navigation related services provider. The output device (111) of Liu et al can be a speaker or a display; thereby the warning is provider either audibly or visually. See columns 2-3. In column 4, Liu et al discloses that the coverage manger interacts with a GPS for predicting the future wireless coverage, wherein the coverage manager notifies the user that he/she will soon lose coverage or soon will regain coverage and then the coverage manger refines the coverage map. That is, the coverage manager downloads data for a second area prior to leaving a first area. As further described in columns 4 and 5, the second area corresponds to a destination to which the user is traveling and which is located outside the first area. Also, the second area corresponds to a portion of a route on which the user's vehicle is located.

Liu et al, in column 3, discloses that the storage device stores navigation/street map and wireless coverage map, which are used to generate route map for the vehicle. Although the navigation/street map and coverage map are disclosed, Liu et al does not particularly disclose the data downloaded when the wireless coverage is unavailable are navigation-related data.

Hashimoto, on the other hand, discloses a vehicle information acquisition system including capability to obtain information in blind spots, i.e., in areas wherein wireless coverage is not available. According to Hashimoto, map information, such as streets,

Art Unit: 3661

main roads, facilities (gas stations, restaurants), are downloaded. See column 4. Hashimoto also discloses a display for displaying areas in which navigations-related data are available or unavailable wirelessly. Thus, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the wireless coverage communication system of Liu et al by incorporating the navigation-related data from the vehicle information acquisition system of Hashimoto because such modification, as suggested by Hashimoto in column 1, would provide a system in which map information can be used even in areas where wireless coverage is not available, thereby enabling the vehicle to keep running smoothly.

7. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al in view of Hashimoto, and further view of Pu et al [6,292,743]

Liu et al, nor Hashimoto, does not particularly disclose highlighting or coloring of the map data and indicating boundaries. Pu et al, on the other hand, discloses a mobile navigation system, which establishes a wireless communication with a navigation server, wherein the map data that are available or unavailable are highlighted. Also, according to Pu et al, there is provided an indication of the boundaries where the data are available. See for example column 10. Thus, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the combination of Liu et al and Hashimoto by incorporating the features from the mobile navigation system of Pu et al, such modification, will eliminate or reduce the burden on the user.

Allowable Subject Matter

8. Claims 18, 19, 34, and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment & Arguments

9. Applicant filed a request for continued examination (RCE) on October 25, 2003. Along with the request, Applicant has amended claim 20 and added claims 24-46. The amendments and the arguments filed therewith have been entered and carefully considered by the examiner.

Applicant primarily argued that Liu et al does not disclose “wirelessly downloading navigation-related geographic data”, nor downloading such navigation-related geographic data “prior to traveling beyond a wireless coverage areas”. Emphasis added.

As mentioned during the interview, the patent to Hashimoto teaches downloading navigation-related data.

As shown in the above rejections, Hashimoto has been used to supplement the teaching of Liu et al. Hashimoto has been used for disclosing the downloaded data as navigation-related data.

It is noted that Liu et al discloses, in column 4, downloading data prior to traveling beyond the wireless coverage area (e.g., prior to entering the uncovered wireless area or leaving the covered wireless area). In addition to the teaching of Liu et al, Hashimoto also discloses downloading data prior to traveling beyond the wireless coverage area (column 6).

Art Unit: 3661

Claims 9-17, 20-33, 35-41, and 43-46 are rejected and claims 18, 19, 34 and 42 are objected to.

In light of the above, the claims are rejected and this office action is made final.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H Louis-Jacques whose telephone number is 703-305-9757. The examiner can normally be reached on M-Th 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on 703-308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1111.

Jacques H Louis-Jacques
Primary Examiner
Art Unit 3661

/jlj
December 8, 2003

Jacques H. Louis-Jacques
JACQUES H. LOUIS-JACQUES
PRIMARY EXAMINER